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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/944,435 | 10/06/97 | LAVENDEL | L 36-P143 |

005514 LM02/0913
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EXAMINER

LUU, S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2773

DATE MAILED: 09/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/944,435

Applicant(s)
Lavendel et al.

Examiner
Sy D. Luu

Group Art Unit
2773



☒ Responsive to communication(s) filed on May 4, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-108 is/are pending in the application.

Of the above, claim(s) 1-73 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 74-108 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Upon initial review of the claims it appears that claims 1-108 differ in subject matter and therefore require a different search. In accordance with this a restriction is deemed proper.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-73, drawn to a specific element in an interface with which a user can interact, classified in Class 345, subclass 339.

Group II. Claims 74-108, drawn to an interface element being a list of selectable items wherein the user may traverse a number of related and linked menu lists, based upon successive choices, classified in Class 345, subclass 353.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a user interface for an image acquisition device. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, and because the searches for the individual Groups are not coextensive, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Nandu Talwalkar on 8/27/99, a provisional election was made without traverse to prosecute the invention of Group II, claims 74-108. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 74-108 are rejected under 35 U.S.C. 102(b) as being anticipated by HP ScanJet 5p Scanner User's Guide ("HP User's Guide", Hewlett-Packard Co., Publication No. C5112-90000, First Edition 9/1996).

As per claim 74, the HP User's Guide discloses a user interface comprising: a property page containing plural elements (depicted by the lower-left figure on page 2-26 titled "HP PictureScan Options", hereinafter figure 2-26); a first interface comprising at least one of the plural elements

(shown as the “Size Setting” option interface in fig. 2-26); a second interface comprising at least one of the plural elements (depicted by the upper-right figure for picture adjustments on page 2-28, hereinafter figure 2-28); wherein the first interface is provided by showing the at least one of the plural elements comprising the first interface and by hiding all other of the plural elements, and wherein the second interface is provided by showing the at least one of the plural elements comprising the second interface and by hiding all other of the plural elements (as shown by figures 2-26 and 2-28).

As per claim 75, the HP User’s Guide discloses said property page having a control region (fig. 2-26, shown as the “Size Settings” control region), and wherein when said plural elements are shown, said plural elements are shown in said control region.

As per claim 76, the HP User’s Guide discloses said property page having a button region (fig. 2-26, shown as the button options to the left of the “Size Settings” control region), said button region having multiple buttons, and wherein the second interface is provided in response to user manipulation of the multiple buttons (for example, the second interface would be provided when the user selects the top-most button indicating that the “Picture Adjustments” interface as shown by fig. 2-28 is desired).

As per claim 77, the HP User’s Guide discloses said first interface and said second interface have at least one common element (such as the multiple buttons in the button region in both figures 2-26 and 2-28), said common element shown both when the first interface is provided and when the second interface is provided.

As per claim 78, the HP User's Guide discloses said plural elements include at least one element selected from the group of list boxes, text boxes, check boxes, slides, buttons, and editable curves (fig. 2-26).

As per claim 79, the HP User's Guide discloses said property page to provide tone control for an image acquisition device (fig. 2-28, as provided by the "Picture Adjustments" option).

As per claim 80, the HP User's Guide discloses the user interface being executed in a windowing environment.

Claims 81, 88, 95 and 102 are similar in scope to claim 74, and therefore are rejected under similar rationale.

Claims 82, 89, 96, and 103 are similar in scope to claim 75, and therefore are rejected under similar rationale.

Claims 83, 90, 97 and 104 are similar in scope to claim 76, and therefore are rejected under similar rationale.

Claims 84, 91, 98, 105 are similar in scope to claim 77, and therefore are rejected under similar rationale.

Claims 85, 92, 99, 106 are similar in scope to claim 78, and therefore are rejected under similar rationale.

Claims 86, 93, 100, 107 are similar in scope to claim 79, and therefore are rejected under similar rationale.

Claims 87, 94, 101, 108 are similar in scope to claim 80, and therefore are rejected under similar rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Donnelly (U.S. # 5,929,851) teaches a GUI through which a user can select an action from a tool bar in order to invoke a desired operation, and including a property action capable of retaining a user selectable data, the property action being selectable by one or more view of that property action provided via the GUI.

Fuller (U.S. # 5,179,653) teaches a menu system incorporates a display surface having sets of buttons displayed thereon.

Mclaughlin et al. (U.S. # 5,739,809) teaches a method and system for display calibration and control.

Responses

10. Responses to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231.**

If applicant desires to fax a response, (703) 308-9051(52) may be used for formal communications or (703) 308-6606 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Inquires

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Sy D. Luu** whose telephone number is (703) 305-0409. The examiner can normally be reached on **Monday - Thursday from 6:30 am to 4:00 pm**. The examiner can also be reached on alternate **Friday**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Matt Kim**, can be reached on (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

SL
Sy D. Luu
Patent Examiner
September 8, 1999

sdl

RAYMOND J. BAYERL
RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2773